REMARKS

Favorable reconsideration of this application in light of the following discussion is respectfully requested.

Claims 11-22, 24 and 29-37 are presently active in this case. The present Amendment amends Claims 30 and 34-35 without introducing any new matter or raising new issues.

In the outstanding Office Action, it is suggested that both Claims 22 and 24 would invoke the sixth paragraph of 35 U.S.C. § 112, and Claims 30 and 34-35 were objected to because of informalities. Claims 32-34 and 36 were rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement. Claims 11, 13, 17, 21-22, 24, and 32-34 were rejected under 35 U.S.C. §103(a) as unpatentable over Bauer, II (U.S. Patent No. 3,692,394, herein "Bauer") in view of Ohshima et al. (U.S. Patent No. 4,821,911, herein "Oshima"); Claims 12 and 14-15 were rejected under 35 U.S.C. §103(a) as unpatentable over Bauer, Ohshima, Hines (U.S. Patent No. 6,122,455), and further in view of Glenn (U.S. Patent No. 4,667,226); Claims 16, 18-19 and 37 were rejected under 35 U.S.C. §103(a) as unpatentable over Bauer, Ohshima, Hines and further in view of Okada et al. (U.S. Patent No. 4,758,905, herein "Okada"); Claim 20 was rejected under 35 U.S.C. §103(a) as unpatentable over Bauer, Ohshima and further in view of Anderson (U.S. Patent No. 6,215,523); and Claims 29-31 and 35-36 were rejected under 35 U.S.C. §103(a) as unpatentable over Bauer, Ohshima and further in view of Hines.

In response to the suggestion that both Claims 22 and 24 can be said to invoke the sixth paragraph of 35 U.S.C. § 112, it is clear that only Claim 22 would do this, not Claim 24.

In response to the objections to dependent Claims 30, and 34-35, Claims 30, and 34-35 are amended to correct the noted informalities. Since the changes are merely formal in nature and were also suggested by the outstanding Office Action,[1] the changes are not

[1] See the outstanding Office Action at page 2, lines 11-19.

believed to raise questions of new matter and any new issues requiring a further search or other consideration on the merits.

In response to the rejection of Claim 1, Applicant respectfully traverses the rejection, since the reference Bauer, relied upon by the outstanding Office Action as a primary reference to form the 35 U.S.C. §103(a) rejections, describes a motion picture camera, where the images are reflected by the forward surface 22 to the reflecting prism 24 and a lens system 26 to an eyepiece 28. As illustrated in Bauer's Figure 1, the optical path is reflected twice by the rotary reflective shutter 16 and the prism 24 to get to the eyepiece 28. Therefore, Bauer ***fails to teach or suggest*** a shutter configured to direct the light to the viewfinder without further change of a viewfinder optical axis.

The outstanding Office Action rejects this feature as being an obvious one, without providing a rejection reference, but by citing the case *In re Karlson*, 311 F.2d 581, 136 USPQ 184, 186 (CCPA 1963), wherein it was held "omission of an element and its function in a combination is an obvious expedient if the remaining elements perform the same functions as before." However, Applicant respectfully disagrees on the outstanding Office Actions' reliance on *In re Karlson*, since this case is believed to be misplaced with regard to the present factual situation, and does not render Applicant's claims obvious, as next discussed.

Contrary to the facts presented in *Karlson*, in which certain elements and their functions are removed and the retained elements perform ***the same functions*** as before, Applicant's Claim 11 includes a shutter that is configured, *inter alia*, to direct the light to the viewfinder along a viewfinder optical axis *without further change of the view finder optical axis*. In view of Applicant's Claim 11 features, if the rationale of the *Karlson* case would be applied to the teachings of Bauer as to eliminating Bauer's reflecting prism 24, the image reflected by the shutter 16 would have to be directly sent to the eyepiece 28, since *Karlson*

states that "the remaining elements perform the same functions as before." This is clearly not the case, as one can see from Bauer's Figure 1.

Accordingly, Applicant's Claim 11 does not perform the same function as Bauer's motion picture camera, since the viewfinder optical axis is not changed, and thereby light is directly reflected by the shutter to the viewfinder. Such feature presents advantages over the teachings of Bauer, since any additional change of the optical axis can increase image distortion of the image seen on the optical viewfinder, and can decrease signal strength of the image seen on the optical viewfinder. In addition, a simpler construction of the elements of the camera can also be obtained.

The PTO reviewing authority has held that the omission of an element and the retention of its function is an indicia of unobviousness. *In re Edge*, 359 F.2d 896, 899, 149 USPQ 556, 557 (CCPA 1966), and the mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. *In re Fritch*, 972 F.2d 1260, 1266 n.14, 23 USPQ2d 1780, 1783-84 n.14 (Fed. Cir. 1992). In addition, such an omission of Bauer's reflecting prism 24 would require a substantial reconstruction or redesign of the mechanical and optical elements of Bauer. There is no evidence that a person of ordinary skill in the art would be motivated to perform such changes and redesign.[2]

The remaining applied references Ohshima, Hines, Glenn and Okada also fail to teach or suggest Applicant's claimed feature regarding a shutter configured to direct the light to the viewfinder without further change of a viewfinder optical axis. While Ohshima and Glenn do not disclose viewfinders, Hines' viewfinder is arranged separate from the main optical axis and Okada's system includes an electronic viewfinder 61 that gets the image from the image

[2] See In re Ratti, 270 F.2d 810, 813, 123 USPQ 349, 352 (reversing an obviousness rejection where the "suggested combination of references would require a substantial reconstruction and redesign of the elements shown in [the primary reference] as well as a change in the basic principle under which the [primary reference] construction was designed to operate.")

sensor 23.[3] Accordingly, the remaining references, taken individually or in combination, also fail to teach or suggest all the features of Applicant's claims and therefore Applicant traverses the rejection of independent Claim 11 and request reconsideration of the rejection.

Since independent Claims 22 and 24 recite analogous features to those recited by Claim 11 in the context of a means-plus-function claim (Claim 22) and a method claim (Claim 24), the rejection of independent Claims 22 and 24 under 35 U.S.C. §103(a) is also believed to be overcome. Regarding Applicant's dependent claims, since the independent Claims 11, 22 and 24 are believed to be allowable, the claims dependent thereon are also believed to be allowable.

In response to the rejection of dependent Claims 32-34 and 36 under 35 U.S.C. §112, first paragraph, Applicant respectfully traverses the rejection, since it can be clearly seen in Figure 1 that "an optical path from the objective support to the optical viewfinder is shorter than an optical path from the objective support to the spectral splitter," and therefore, Applicant clearly was in possession of the claimed invention at the time the application was filed. Figure 1 clearly shows the respective optical paths (see for example reference numeral 14) and the lengths thereof. Applicant respectfully submits that not only the specification provides a written description, but the entire disclosure together with the original claims and the drawings must be considered. See *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 19 USPQ2d 1111 (Fed. Circuit), stating that "drawings constitute an adequate description if they describe what is claimed and convey to those of skill in the art that the patentee actually invented what is claimed" and "[t]hat combination invention is what the [patent's] drawings show" and at MPEP §2163.06 stating that "information contained in any one of the specification, claims or ***drawings*** of the application as filed may be added to any other part of

[3] See Hines in Figure 12 and 13.

the application without introducing new matter" (emphasis added). Accordingly, Applicant respectfully requests the withdrawal of this rejection of dependent Claims 32-34 and 36.

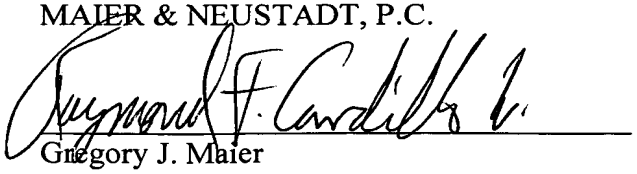
The present amendment is submitted in accordance with the provisions of 37 C.F.R. §1.116, which after Final Rejection permits entry of amendments placing the claims in better form for consideration on appeal. As the present amendment is believed to overcome outstanding objections to Claims 30, 34-35, the present amendment places the application in better form for consideration on appeal. In addition, the present amendment is not believed to raise new issues because the changes to Claims 30, 34-35 were proposed by the outstanding Office Action and are merely formal in nature. It is therefore respectfully requested that 37 C.F.R. §1.116 be liberally construed, and that the present amendment be entered.

Consequently, in view of the present amendment, no further issues are believed to be outstanding in the present application, and the present application is believed to be in condition for formal Allowance. A Notice of Allowance for Claims 11-17, 19-22, 24 and 29-37 is earnestly solicited.

Should the Examiner deem that any further action is necessary to place this application in even better form for allowance, the Examiner is encouraged to contact Applicant's undersigned representative at the below listed telephone number.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.



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